



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/762,200	01/21/2004	Raymond T. Bartus	2685.1009-US3	2522

38421 7590 03/17/2006

ELMORE PATENT LAW GROUP, PC
209 MAIN STREET
N. CHELMSFORD, MA 01863

EXAMINER

HAGHIGHATIAN, MINA

ART UNIT	PAPER NUMBER
----------	--------------

1616

DATE MAILED: 03/17/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/762,200

Applicant(s)

BARTUS ET AL.

Examiner

Mina Haghighatian

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 01/21/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim 13 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 13 is vague and indefinite because it recites the terms "citrate" and "a multivalent salt" it is not disclosed and not clear what these salts are. It is not clear if applicant meant that alprazolam is in a citrate salt or there is another citrate salt present. The multivalent salt is also not identified.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1-3 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drug Information Handbook in view of Newman.

Drug Information Handbook teaches that alprazolam is used for treating anxiety, depression and management of panic attacks. Dosages for oral administrations are disclosed. Drug Information Handbook lacks teachings on the inhalation administration or dosage for inhalation administration.

Newman teaches that inhalation therapy has several advantages over oral or intravenous administrations including a small dose of drug can be used. For example a few hundred micrograms of beta-agonist may be as effective as a 10 mg oral dose. Another advantage is the rapid onset of actions, where an inhaled bronchodilator is effective within 5 minutes and reaches peak effect in 15 to 30 minutes compared to 2 to 3 hours for an oral dose (see 1st column on page 152s). Newman also discloses MMAD for the particles of less than 5 microns, preferably from 2 to 5 microns. Particles are administered using an MDI or a nebulizer (see pages 154s and 155s).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have implemented the teachings of Newman on advantages of inhaled drugs over oral drugs with the treatment of CNS disorders by alprazolam in order to have a more efficient therapy method where less drug is used, for a faster onset and less side effects.

Claims 4-7 and 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Drug Information Handbook in view of Newman and further in view of Platz et al (6,019,968).

The combined references, discussed above, lack specific disclosure on dry powders and excipients.

Platz teaches dispersible dry powder compositions and method of making and using them. The said dry powders comprise an average particle size from 1-4 micron and a particle density of 1.44 g/cm³ (see col. 7, lines 20-29 and col. 9, lines 59-67). The MMAD is also less than 5 microns (see col. 10, lines 21-25 and examples 2, 3, 5). The formulations comprise from 40 to 100% of the active agent (see col. 8, lines 21-28). The particles are administered and delivered to the alveolar regions of the lung (col. 8, lines 31-35). Suitable excipients include amino acids, peptides, carbohydrates, etc, and suitable pH adjusters include sodium citrate (see col. 8, lines 47-67).

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,979,437. Although the conflicting claims are not identical, they are not patentably distinct from each other because the examined claims are anticipated by the reference claims. Specifically the examined claims are drawn to a method of treating a CNS disorder by pulmonary administration of alprazolam. The reference claims are drawn to a method of treating a CNS disorder by pulmonary administration of a drug. Alprazolam meets the broad scope of a drug. The remaining limitations are substantially or exactly the same.

Claims 1-16 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of U.S. Patent No. 6,613,308. Although the conflicting claims are not identical, they are not patentably distinct from each other because the examined claims are anticipated by the reference claims. Specifically the examined claims are drawn to a method of treating a CNS disorder by pulmonary administration of alprazolam. The reference claims are drawn to a method of treating Parkinson's disease by pulmonary administration of a drug. Alprazolam is disclosed in

the specification of U.S. Patent No. 6,613,308 as a suitable drug (see col. 7, lines 8-10 and col. 9, lines 15-21). The remaining limitations are substantially or exactly the same.

Claims 1-16 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims of copending Application No. 10/895,577. Although the conflicting claims are not identical, they are not patentably distinct from each other because the examined claims are anticipated by the reference claims. Specifically the examined claims are drawn to a method of treating a CNS disorder by pulmonary administration of alprazolam. The reference claims are drawn to a method of treating a CNS disorder by pulmonary administration or treating Parkinson's disease by pulmonary administration of a drug. Benzodiazepines are claimed as a suitable drug. The remaining limitations are substantially or exactly the same.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mina Haghighatian whose telephone number is 571-272-0615. The examiner can normally be reached on core office hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gary L. Kunz can be reached on 571-272-0887. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1616

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Mina Haghighatian
March 06, 2006


Mina Haghighatian
Patent Examiner
Art Unit 1616